APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,805	09/29/2000	Joseph R. Stonoha	632.0001USU	2958

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Charles N.J. Ruggiero, Esq.
Ohlandt, Greeley, Ruggiero & Perle, L.L.P.
10th Floor
One Landmark Square
Stamford, CT 06901-2682

EXAMINER
COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/676,805	STONOHA ET AL.
	Examiner	Art Unit	
	Edward R. Cosimano	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 September 2005</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>See Continuation Sheet</u> is/are pending in the application.

    4a) Of the above claim(s) <u>none</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,5-7,10,14,15,19,23,24,28-31,33-35,37-42,44-46,48-53,55-57,59,60 and 73-75</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>02 March 2005</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1,5-7,10,14,15,19,23,24,28-31,33-35,37-42,44-46,48-53,55-57,59,60 and 73-75.

1.   In view of the following new rejection based on new prior art, the finality of the last Office action is WITHDRAWN.

2.   Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119(e) is acknowledged.

3.   The set of drawings filed 02 March 2005 containing the approved proposed drawing corrections filed 16 October 2003 and 19 March 2004 and 30 August 2004 have been approved by the examiner.

4.   The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(b-f).

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.1   Claims 73-75 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Ogura et al (5,448,685) in view of how one of ordinary skill would fairly interpret the phrase "ad hoc job".

5.1.1   In regard to claims 73-75, Ogura et al ('685) discloses a computer implemented machine/process that under the control of an operating program stored in the memory of the machine implements the functions/acts of generating and printing various labels that contain both text and/or graphics. To this end, the control processor, of the label generating and printing machine/process, while executing the operating program, that is stored in the memory, permits the user to design labels by using a display to present various screens containing various selections and an input device to receive an indication of the user's selections. Further the operating program causes the process to display a sequence or series of screens based on the user's selection of a currently displayed selection, that is different selections by the user will lead

to additional displayed screens of additional selections. In this manner the user is lead through the process of designing any number of labels. After the user has finished designing labels, the user may make further selection of the labels that will be printed as a print job on the printer that is associated with the label generation machine/process, (see fig. 7 and at column 7, lines 31-39; column 9, lines 32-60; column 23, lines 17-24 of Ogura et al ('685)).

5.1.2   It is noted that Ogura et al ('685) does not use a the phrases "ad hoc job" or "serial job" to designate the print job of labels as recited in the instant claims, however, it is noted that applicant has defined an "ad hoc job" in the paragraph located at page 8, lines 16-24, "Referring to FIG. 6, a display screen 90 is presented on display 46 when a user selects an ad hoc job for creating labels. An ad hoc job includes a variety of different labels that may or may not be related. For instance, an ad hoc job may include replacement labels for an existing set of labels. Some of these labels will bear no ordered sequential relation to other labels in the job. However, the ad hoc job is versatile enough to include a group of labels that have an ordered sequence.", {emphasis added}. In view of applicant's own definition that an "ad hoc job" is a print job containing a number of labels and is versatile enough to include a series of labels either in (1) a sequential order; or that are not in a sequential order, it is noted that one of ordinary skill at the time the invention was could interpret any label print job of Ogura et al ('685) as the disclosed and claimed "AD HOC JOB".

6.   The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time

the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6.1   Claims 1, 5-7, 10, 14, 15, 19, 23, 24, 28-31, 33-35, 37, 39-42, 44-46, 48, 50-53, 55-57 & 59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ogura et al (5,448,685) in view of how one of ordinary skill would fairly interpret the phrase "ad hoc job" as applied above to claims 73-75 and further in view of Best et al (5,533,176).

6.1.1   In regard to claims 1, 5, 10, 14, 19, 23, 28, 29, 33-35, 37, 39-40, 44-46, 48, 50-51, 55-57 & 59, although Ogura et al ('685) discloses that the text and/or graphics to appear on a label is automatically scaled to fit the printable area of a designated label Ogura et al ('685) does not disclose that the "positional palette" or the size, rotation and appearance of any text and/or graphic that is to appear at each of the specific printable locations on the label may be designated by the user. However, Best et al ('176) in the environment of label design and printing discloses a computer implemented machine/process that under the control of an operating program stored in the memory of the machine implements the functions/acts of generating and printing various labels that contain both text and/or graphics. To this end, the control processor, of the label generating and printing machine/process, while executing the operating program, that is stored in the memory, permits the user to design one or more labels by designating at each printable location on a label the "positional palette" or the size, rotation and appearance of any text or graphic that is to appear at each of the specific printable locations on the label. After the user has finished designing labels, the user may make further selection of the labels that will be printed as a print job on the printer that is associated with the label generation machine/process, (see fig. 1 and column 4, line 41, through column 8, line 20).

6.1.2   Since the ability of designating the "positional palette" or the size, rotation and appearance of any text or graphic that is to appear at each of the specific printable locations on the label as taught by Best et al ('176) would provide a more versatile and desirable label making machine/process than the label making machine/process of Ogura et al ('685), it would have been obvious to one of ordinary skill at the time the invention was made that the label making machine/process of Ogura et al ('685) could be modified to permit the user the versatility of designating the "positional palette" or the size, rotation and appearance of any text or graphic

that is to appear at each of the specific printable locations on the label as taught by Best et al ('176).

6.1.3   In regard to the suppression of claims 6, 7, 15 & 24, it is noted that if the user does not designate the content of any one or more of the printable positions/locations of the label in the machine/process of Ogura et al ('685) in view of how one of ordinary skill would fairly interpret the phrase "ad hoc job" and modified by Best et al ('176), then it would have been obvious to one of ordinary skill at the time the invention was made that the user's failure to designate the content any one or more of the printable positions/locations of the label during the process of generating a label as an indication that any character/graphic at that location on the label being designed is to be suppressed.

6.1.4   In regard to claims 30, 31, 41, 42, 52 & 53, it is noted that one of ordinary skill at the time the invention was made would have inherently recognized that:

> A) the character to be printed could be a "prefix"; or
>
> B) the character to be printed could be a "suffix";

relative to any of the other characters to be printed on a label as the meaning of the words "prefix" and "suffix" would be understood by one of ordinary skill.

6.2   Claims 38, 49 & 60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ogura et al (5,448,685) in view of how one of ordinary skill would fairly interpret the phrase "ad hoc job" as modified by Best et al (5,533,176) as applied above to claims 1, 5-7, 10, 14, 15, 19, 23, 24, 28-31, 33-35, 37, 39-42, 44-46, 48, 50-53, 55-57, 59 & 73-75 and further in view of Drisko (4,718,784) and Benada et al (5,621,864).

6.2.1   In regard to claims 38, 49 & 60, it is noted that while the label making machine/process of Ogura et al ('685) in view of how one of ordinary skill would fairly interpret the phrase "ad hoc job" as modified by Best et al ('176) would permit the user to designate a sequence of numbers to be placed on a label, this sequence of numbers in designated as a serial number on the label where the last printed serial number in a sequence is saved for future use when designing additional labels.

6.2.2   In this regard it is noted that in 1988 Drisko ('784) disclosed a computer implemented machine/process which under the control of an operating program stored in a memory performs the functions/acts of permitting an user to design one or more labels and then designate which of

the designed labels are to be printed as a single print job on an supply of labels stock containing label that are arranged in one or rows and columns. To this end, the machine/process of Drisko ('784) includes the user of a control processor, memory, display, input device and printer that cooperate to permit the user to enter information/data that would:

A) for each label to be designed to define/designate for each printable character position/location on each label being designed the one or more alphanumeric characters, for example, text and/or serial numbers, or graphics, for example, a barcode, that is to appear on the label at each of the printable position/location on the label;

B) for each printable character position/location on each label being designed to define/designate a customized pallet that would define/designate the font size to be used and whether the character is to appear using bold print for each printable character position/location, where the pallet;

C) for each designed label by the user, to designate the quantity of labels to be printed in a print queue/job as well as the order/sequence in which the designated labels are to be printed in the print queue/job; and

D) permit the user to place a label serial number on a label.

Based on the entered information, the user may preview the designed label including the relative positions of the alphanumeric/graphical content of the label on a display. Further, when the print queue/job is to be printed as indicated by an entry from the user, the designated labels would be printed beginning on a designated label, for example the first available label, on the label stock and then serially on each available label in the rows/columns of labels on the label stock. Where once the user has designated the appearance of a character/graphic, then that designated appearance would be used for each sequential printable location on the label until a new appearance of a character/graphic was designated.

6.2.3   However, Drisko ('784) does not save the last serial number used so that the next label to be designed that includes a label serial number would use the next available succeeding serial number. However, in the environment of designing and generating customized labels, Benada et al ('864) discloses a computer implemented machine/process which under the control of an accessible operating program stored in a memory performs the function of permitting an user to design one or more labels that are to be sequentially identified by an unique indicia. To this end,

the machine/process of Benada et al ('864) as would be inherently recognized by one of ordinary skill at the time of the invention was made that Benada et al ('864) would include a system/process that would keep track of the last unique indicia in the sequence of unique indicium that has been used so that no two labels would be potentially confused with one another, since both labels would have the same unique identifier. Since the user of the machine/process of Drisko ('784) when assigning serial numbers to labels would not want to have two labels with the same serial number so as to cause confusion, it would have been obvious to one of ordinary skill at the time of the invention that the label generation machine/process of Drisko ('784) could be modified to keep track of what serial numbers have been used as taught by Benada et al ('864), so that no two labels produced by the machine/process of Drisko ('784) could be confused by using the same serial number.

6.2.4   Further since the ability to place and designate unique serial numbers on labels would be desirable so that no two labels would be confused by anyone or anything as the same label, it would have been obvious to one of ordinary skill at the time the invention was made that the label making machine of Ogura et al ('685) in view of how one of ordinary skill would fairly interpret the phrase "ad hoc job" as modified by Best et al ('176) could be further modified to include the ability to place unique serial numbers on labels and to remember the last serial number used as taught by Drisko ('784) as modified by Benada et al ('864).

7.   Response to applicant's arguments.

7.1   All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

8.   The examiner has cited prior art of interest, for example:

        A) Davidson et al (5,615,123) discloses a machine/process in which an user designs an item by being lead through a sequence of a number of different display screens that contain various options that may be selected by the user an the next display screen presented to the user is based on the selection option contained in the previous display screen.

9.   The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (571) 272-6802. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (571) 272-6812. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3600.

10.1   The fax phone number for **UNOFFICIAL/DRAFT FAXES** is (571) 273-6802.

10.2   The fax phone number for **OFFICIAL FAXES** is (571) 273-8300.

10.3   The fax phone number for **AFTER FINAL FAXES** is (571) 273-8300.

09/28/05

Edward Cosimano

Edward R. Cosimano
Primary Examiner Unit 3639